

REMARKS

The present patent application has been reviewed in light of the office action, dated January 20, 2006, in which the title is objected to as not being descriptive. Claims 18-19, and 21-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beckert et al., U.S. Patent No. 6,202,008 (hereinafter "Beckert"). Claims 27-30 and 32-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert. Claims 20 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Kagle et al., U.S. Patent No. 6,601,056 (hereinafter "Kagle"). Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Jones et al., U.S. Patent No. 6,438,638 (hereinafter "Jones"). Claims 31 and 36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in further view of Jones. Reconsideration of the above-referenced patent application in view of the foregoing amendment and following remarks is respectfully requested.

Claims 18-36 are pending. Claims 18-27 have been amended. Assignee has amended claims to more clearly delineate intended subject matter. Amendments to claims are made without prejudice or disclaimer, and Assignee believes that none of the clarifying claim amendments constitute narrowing amendments. In fact, some of these claim amendments are intended to be broadening amendments. Accordingly, Assignee does not intend to surrender claimed subject matter by submission of the above amendments and no prosecution history estoppel should apply.

Objections to the Title

The title has been amended to be more descriptive. Assignee therefore respectfully requests that the objection to the title be withdrawn.

Rejections under 35 U.S.C. § 102(b)

Claims 18-19, and 21-24 are rejected under 35 U.S.C. § 102(b) as being anticipated by Beckert. However, Beckert does not disclose "an optical media reading device" comprising

"a memory card slot capable of receiving a memory card;
a digital video and audio decompressing card coupled to said memory
card slot and capable of processing a video signal from the
memory card" (emphasis added)

as claimed in amended claim 18. Beckert does not disclose a memory card slot incorporated into an optical media reading device. For example, see Figures 2 and 3 of Beckert where the optical media reading device (CD-Rom Changer I/F 78) is clearly shown to be separate from the memory card slots (card slot interfaces 135 and 136 as part of Computer Module 64). Further, Beckert does not disclose processing video signals received from a memory card in the memory card slot. Therefore, independent claim 18 and the claims that depend from it are believed to patentably distinguish from the cited patent. It is, therefore, respectfully requested that the Examiner withdraw the rejection as to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patent for additional reasons; however, the foregoing is believed to be sufficient.

Rejections under 35 U.S.C. § 103(a)

Claims 27-30 and 32-36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert. Claims 20 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Kagle. Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in view of Jones. Claims 31 and

36 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Beckert in further view of Jones.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Assignee's disclosure." MPEP § 2143. Assignee respectfully submits that the Examiner has not established a *prima facie* case of obviousness. The cited patents do not teach or suggest all the limitations of the aforementioned claims. Neither Beckert nor Kagle nor Jones disclose, either alone or in combination,

"determining a file format, reading the compressed digital image, decompressing the compressed digital image, and outputting the decompressed image are performed by an optical media reading device" (emphasis added)

as claimed in claim 27. Similarly, neither Beckert nor Kagle nor Jones disclose, either alone or in combination

"an optical media reading device adapted to:
determine a file format for a compressed digital image stored on a memory card;
read the compressed digital image from the memory card;
decompress the compressed digital image; and
output the decompressed image at an output port" (emphasis added)

as claimed in claim 32. Therefore, claims 27 and 32 and the claims that depend from them are patentably distinguished over the cited patents. Assignee respectfully requests that the Examiner withdraw his rejections to these claims.

It is noted that claimed subject matter may be patentably distinguished from the cited patents for additional reasons; however, the foregoing is believed to be sufficient. Likewise, it is noted that the Assignee's failure to comment directly upon any of the positions asserted by the Examiner in the office action does not indicate agreement or acquiescence with those asserted positions.

CONCLUSION

In view of the foregoing, it is respectfully asserted that all of the claims pending in the present patent application are in condition for allowance. If the Examiner has any questions, he is invited to contact the undersigned at (503) 439-6500.

Reconsideration of the present patent application and early allowance of all the claims is respectfully requested. Please charge any underpayments or credit any overpayments to deposit account no. 50-3703.

Respectfully submitted,

Dated: 7/20/06

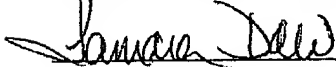
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